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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,871	04/18/2000	Kazunari Yoshida	0020-4699P	2420

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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/551,871
Filing Date: April 18, 2000
Appellant(s): YOSHIDA ET AL.

Birch, Stewart, Kolasch, & Birch LLP
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 25, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No After Final Amendment was submitted, though the appellant failed to acknowledge so.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because none of the groups are separately patentable over the cited art.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. (USPN 6045459).

Sugimoto et al discloses a three-piece golf ball, with excellent rebounding performance, flight performance, durability, and shot feel, having an inner layer core (1), an outer layer core (2), and a cover (3) (See Abstract and Figure 1). The inner core has a diameter of 31 to 36mm and a JIS-C hardness of 60 to 85 (See Column 2, lines 33 through 46). Sugimoto et al. also discloses that when the surface hardness of the inner layer core exceeds the center hardness of the inner layer core that the shot feel and durability is affected (See Column 2, line 33 through 46). Sugimoto et al. also discloses the inner core and the outer core being composed of the same material, in which polybutadiene, a co-crosslinking agent, organic peroxide, and a filler are noted (See Column 3, lines 8 through 60). The crosslinking agent is disclosed as including monovalent or divalent metal salts of a α,β -unsaturated carboxylic acid having 3 to 8 carbon atoms, in which magnesium and methacrylic acid is noted (See Column 3, lines 8 through 38). Sugimoto et al. also discloses that when the thickness of the outer layer

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is smaller than 1mm, that the shot feel is affected (See Column 2, lines 60 through 67).

The applicant is using negative statistics, meaning not desired or "non-preferred" properties, in order to obtain an improved golf ball. Furthermore, the cover has a thickness of 1 to 4mm and a Shore D hardness of 55 to 75 (See Column 4, lines 15 through 38). Sugimoto et al. clearly prefers a softer ball than that claimed by the applicant, but the discloses the effects of the negative, or non-preferred properties which would result in the golf ball being harder. Also note that Comparative Example 3, in Table 5, shows a golf ball having ordinary feel when the surface hardness of the inner layer core exceeds the center hardness of the inner layer core. Therefore, it is clearly defined by Sugimoto et al. that increasing the hardness of the surface layer would result in having a different feel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a negative statistics, or non-preferred properties, of Sugimoto et al., by having a center hardness lower than the surface hardness and a cover thickness less than 1.0mm, in order to optimize the shot feel and durability to that desired for the golf ball.

(11) Response to Argument

In the reply dated February 19, 2002, the appellant argues that Sugimoto et al. does not teach the same result as that of the present invention in reference to the core thickness, core hardness. The appellant also alleges that Hayashi et al. was relied upon to compare the present invention.

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First and foremost, there was no usage of Hayashi et al. in the final office action and therefore, does not apply to the issues of the appeal. The appellant relies on the preferred embodiment disclosed by Sugimoto et al. in comparison to the present invention and not the entire disclosure as a whole as refers to MPEP Section 2173.05(i) as a means of proof. Unfortunately, the issues of the appeal do not concern negative limitation within a claim, in which MPEP Section 2173.05(i) refer to. In MPEP Section 2123, it states what materials may be used as prior art in which it noted that "Non-Preferred Embodiments" also constitute as prior art. Also noted under "Non-Preferred Embodiments" is In re Susi, (F.2d 442., 169 USPQ 423 (CCPA 1971) which states, "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." As noted above the appellant uses the preferred embodiment of Sugimoto et al. in comparison to the present invention, when Sugimoto et al. also notes the effects of changing the core hardnesses and the thickness of the outer layer.

For these reasons, it is believed that the rejection should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

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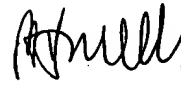
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Alvin A. Hunter, Jr.
March 8, 2002

CONF:

Respectfully submitted,



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~~Steven Wong~~
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